

AMENDMENT UNDER 37 C.F.R. § 1.111

U.S. Appln. No. 09/311,753

Attorney Docket No. Q54370

REMARKS

In Paragraph Nos. 2 and 6 of the Office Action, the Examiner indicated that the §1.132 Declaration has not been officially considered because it is “currently” unsigned.

Applicants respectfully submit that an executed §1.132 Declaration has been properly submitted to the PTO on January 23, 2004, as evidenced by the PTO stamped filing receipt. Applicants attach herewith copies of Submission of Executed Declaration under 37 C.F.R. § 1.132 along with the executed Declaration and the PTO stamped filing receipt.

In the present Amendment, claim 2 has been amended to recite --wherein the protective sheet has satisfactory performance on curved surfaces--. This amendment is supported by the specification, for example, in the working examples, in particular, the Table.

No new matter has been added and entry of the Amendment is respectfully requested. Upon entry of the Amendment, claims 2 and 3 will be all the claims pending in the application.

In Paragraph No. 4 of the Office Action, claims 2 and 3 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Miyahara et al. in view of Arakawa et al. (JP ‘528), Müssig or Matsui et al. (EP ‘354). Further, in Paragraph No. 5 of the Office Action, claims 2 and 3 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Seth (‘964) in view of JP ‘528, Müssig or EP ‘354.

Applicants respectfully traverse the rejections for at least the following reasons.

Regarding the Declaration, the Examiner asserted that the present claims do not contain any limitations directed to the improved properties.

Applicants respectfully disagree. The comparative data in the Declaration is presented to show the unexpected superiority of the present invention, to thereby traverse the 103 rejection over the cited references. These improved properties of the present invention, in terms of follow-up performance to curved surfaces, water permeability, peeling properties and adhesion strength, are inherent in the protective film of the present invention, and thus do not constitute further limitations. MPEP 716.02 does not require such properties be recited in the claims.

The Examiner asserted that it would have been obvious to one of ordinary skill in the art to use the adhesive of Miyahara et al or Seth in a method of protecting a paint film of an automobile from debris and dirt as taught by the secondary references. The Examiner also asserted that one of ordinary skill in the art would have known to use an adhesive that would be peelable to prevent damage to the paint when the film is removed.

Applicants respectfully disagree. As set forth in the Response of December 22, 2003, the tape of Miyahara et al provides a permanent adhesion, and is designed so that it is difficult to peel off the tape from an adherend. See page 2, lines 5-7 from the bottom. In addition, as the results in the Declaration clearly show, the films of Miyahara et al and Seth have poor peeling properties, and thus cannot be used as a protective sheet for a paint film of an automobile. That is, the Examiner's two assertions cannot be satisfied simultaneously.

Nonetheless, to facilitate the prosecution, Applicants have amended claim 2 to further recite that "the protective sheet has satisfactory performance on curved surfaces." As clearly shown in the Declaration, the examples of Miyahara et al and Seth do not have good follow-up performance on curved surfaces.

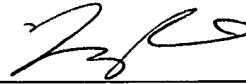
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For the foregoing reasons, Applicants respectfully submit that the present inventions is patentable over the cited references, and the rejections should be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

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